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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,542	02/06/2002	Bo. T. Claridge	053328-124695	8006
27148 7590 06/01/2009 POLSINELLI SHUGHART PC 700 W. 47TH STREET SUITE 1000 KANSAS CITY, MO 64112-1802				
EXAMINER				
BUCHANAN, CHRISTOPHER R				
ART UNIT		PAPER NUMBER		
3627				
MAIL DATE		DELIVERY MODE		
06/01/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/068,542

**Applicant(s)**

CLARIDGE ET AL.

**Examiner**

CHRISTOPHER R. BUCHANAN

**Art Unit**

3627

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-12 and 30-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-12, and 30-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 19, 2009 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4-12, and 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke (US 6,112,191), in view of Barton (US 6,164,533).

Regarding claims 1, 9, and 30, Burke discloses a method for effectuating an investment including completing a point-of-sale transaction by a user at a point-of-sale location (col. 2 line 55+) using an electronic payment method (check, credit, debit cards) associated with a purchasing or savings account (col. 6 line 62+, check or debit card are purchasing or savings accounts, amount is charged to account), receiving by a

computer a request to complete a distinct on-demand investment transaction (deposit/distribution into bank or other account is interpreted as an investment, col. 6 line 65+, col. 8 line 1+, and is a distinct transaction as consumer enters amounts to be credited to various predetermined accounts, col. 6 line 1-8) after completion of the point-of-sale transaction (pos transaction over once funds are allocated to purchase and change is determined, col. 6 line 62+), identifying by the computer investment preference information associated with the user (col. 6 line 1+, col. 8 line 1+, user enters amounts, selects accounts, etc.) in response to receiving the request wherein the preference information includes the purchasing or savings account (col. 6 line 60+, col. 7 line 63+) linked to an investment account (col. 8 line 1-10, linked to bank, debit, voucher accounts since money is transferred from one account to another), and causing by the computer funds relating to the investment amount to be transferred from the purchasing or savings account to an investment account (col. 8 line 1+, Figs. 4A-4C).

Burke does not explicitly disclose that the investment-preference information includes a predetermined monetary investment amount for the on-demand investment.

However, Barton discloses a similar method of investment, which shows that the investment-preference information includes a predetermined monetary investment amount for the on-demand investment (col. 5 lines 44-50).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Burke to include in the investment-preference information a predetermined monetary investment amount for the on-demand investment, in accordance with the teachings of Barton, in order to assist a user in

achieving a regular, budgeted investment goal by suggesting a default investment amount (e.g., one dollar of surplus for each transaction) with each purchase being made when using a purchasing or saving account (see Barton col. 3 line 42-45).

Regarding claim 4, the method of Burke further comprises the step of temporarily accumulating the on-demand investment requests until a predetermined completion time. See, in particular, column 3, lines 4-13.

Regarding claims 5-8, Burke does not disclose any investment limit/maximum, thus does not disclose accommodating an investment limit/maximum by including an investment total and a predetermined investment limit in the investment-preference information and, if the on-demand investment request would cause the limit/maximum to be exceeded, avoiding exceeding the maximum by either canceling the on-demand investment request or rolling the on-demand investment request over to a secondary/alternate investment account. However, Barton discloses a similar method of investment, which method indeed includes contributing the on-demand investment request to an investment account having a limit/maximum (an IRA). See, in particular, column 5, lines 44-50. Since canceling a deposit or rolling it over to a secondary/alternative account are self-evident and well known, hence obvious, steps to perform in order to avoid exceeding a limit/maximum of an investment account having a limit/maximum, such as an IRA, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Burke so as to invest in an account having an investment limit/maximum, in accordance with the teachings of Barton, and to accommodate the investment limit/maximum by not exceeding it, by

including an investment total and a predetermined investment limit in the investment-preference information and, if the on-demand investment request would cause the limit/maximum to be exceeded, avoiding exceeding the maximum by either canceling the on-demand investment request or rolling the on-demand investment request over to a secondary or alternate investment account, as is self-evident and well known to do, in order to obey the law by complying with limits/maximums imposed on certain investment accounts, such as IRAs, by the law, and since so-doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claims 10 and 11, the method of Burke comprises associating a purchasing account with an investment account and using either the purchasing account or a source other than the purchasing account to contribute to the investment account (col. 12 lines 11-16).

Regarding claim 12, the method of Burke includes receiving, from the purchaser at the point-of-sale location, a request to specify the monetary investment amount. Therefore, the combination described above with respect to claim 1 would inherently include the step of receiving, from the purchaser at the point-of-sale location, a request to modify the predetermined monetary investment amount, since simply specifying an amount is equivalent to modifying a predetermined amount of zero to any non-zero amount.

Regarding claims 31 and 32, the predetermined amount of money could be determined in a variety of ways (selecting a given amount, a percentage of the transaction, etc.) and the particular means selected would be a matter of design choice.

Regarding claims 33 and 34, the payment method includes a credit card, a debit card, etc. (col. 6 line 60+) and the purchasing account could include a checking account, savings account, etc.

#### ***Response to Arguments***

4. Applicant's arguments filed March 19, 2009 have been fully considered but they are not persuasive. Applicant argues that the prior art references do not disclose all of the recited features of the claimed invention and that there is no motivation to combine the teachings of the references. In particular, it is argued that the Burke reference does not show a purchase or savings accounts linked to an investment account, a distinct on-demand investment, or a predetermined monetary investment amount determined prior to the pos transaction. Also, applicant argues that the references teach away from the claimed invention and that the combination would produce an inoperable device.

The examiner disagrees and stands by the rejection. As pointed out in the rejection above, bank, debit, or other accounts, as disclosed by Burke, are considered to be investment accounts and deposits into them are considered to be investment transactions. These investment accounts are linked to the payment account since the surplus amount is transferred from the payment account to the investment account, and could be linked prior to or at the time of the pos transaction. In the examiner's view, this

constitutes the accounts being "linked". Also, Burke shows the investment transaction occurring after completion of the point-of-sale transaction. This is taken to be the point at which funds are allocated for the pos purchase and change is determined, which is then directed toward the investment transaction according to the user's instructions (i.e., on-demand). Lastly, the inventions of Burke and Barton are closely related, both being directed to saving excess funds from a point of sale transaction, and constitute analogous art. Their inventions are similar to and do not teach away from the claimed invention. Motivation for the combination of Burke and Barton is provided in the rejection above and, in the examiner's view, the combination produces a fully operational invention. Merely modifying the method of Burke so that that the investment-preference information includes a predetermined monetary investment amount for the on-demand investment does not make the method non-operational.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER R. BUCHANAN whose telephone number is (571)272-8134. The examiner can normally be reached on Mon.-Fri. 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. R. B./  
Examiner, Art Unit 3627

/F. Ryan Zeender/  
Supervisory Patent Examiner, Art Unit 3627